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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,576	07/27/2001	Noriko Yagi	1403-0214P	8192
2292	7590	11/12/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/915,576	YAGI ET AL.	
	Examiner	Art Unit	
	Katarzyna Wyrozebski Lee	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

In the amendment filed on 9/8/2003 the applicants have amended claim 1 and inserted limitation of a particle size of the clay component. The applicants also cancelled claims 2 and 5.

In view of the amendment and newly incorporated limitation, the following office action is final as necessitated by amendment.

The applicants have also submitted new specification. It is examiner's position that the changes to the specification are purely grammatical, for better, and no new matter is introduced. The new specification will be entered.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over STUHLBREHER (US 6,080,809) in view of FUKUMOTO (US 5,591,794).

The discussion of the disclosure of the prior art of STUHLBREHER from paragraph 2 of the office action mailed on 6/6/2003 is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of STUHLBREHER is in particle size of the clay.

With respect to the above difference, the prior art of FUKUMOTO teaches that the clay component that is utilized in making tire treads has particle size of 1 micron (col. 2, lines 42-45) since it has better reinforcing properties.

Use of clay component having particle size of 1 micron provides composition-having clay with good reinforcing properties.

In the light of the above disclosure it would have been obvious to one having ordinary skill in the art at the time of the instant invention, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize clay of FUKUMOTO in the composition of STUHLBREHER and thereby obtain the claimed invention. Using clay having particle size, as that disclosed in FUKUMOTO would provide adequately reinforced tire tread composition.

5. Claims 1, 3, 4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over HERGENROTHER (US 6,342,552).

The discussion of the disclosure of the prior art of HERGENROTHER from paragraph 3 of the previous office action mailed on 6/6/2003 is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of HERGENROTHER is in particle size of the clay.

With respect to the above difference, the prior art of FUKUMOTO teaches that the clay component that is utilized in making tire treads has particle size of 1 micron (col. 2, lines 42-45) since it has better reinforcing properties.

Use of clay component having particle size of 1 micron provides composition-having clay with good reinforcing properties.

In the light of the above disclosure it would have been obvious to one having ordinary skill in the art at the time of the instant invention, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize clay of FUKUMOTO in the composition of HERGENROTHER and thereby obtain the claimed invention. Using clay having

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particle size, as that disclosed in FUKUMOTO would provide adequately reinforced tire tread composition.

In the amendment filed on 9/8/2003 the applicants have argued following:

a) The prior art of STUHLBREHER teaches kaolin clay having median particle size of about 0.2 microns, which upon amendment falls outside the claimed range.

That is not exactly the case. The prior art of STUHLBREHER stated following.

The kaolin clay of the present invention is also known as hydrated aluminum silicate and can be air-floated or water-washed (having a median particle size of from about 0.2 microns). The kaolin clay is substituted on a 1:1 weight basis

This signifies that the particle size is about 0.2 microns or greater. However, since the specific range is not disclosed a 103 rejection in view of FUKUMOTO is applied, wherein the prior art of FUKUMOTO teaches that generally tire treads utilize clay having particle size of 1 micron, because of their reinforcing property. If what FUKUMOTO teaches that such is a general knowledge, then others skilled in the art would know that and utilizing such clay in the composition of STUHLBREHER would have been obvious.

b) The prior art of HERGENROTHER does not disclose clay having particular average particle size.

Since the prior art of HERGENROTHER does not disclose specific range of the average particle size of the clay component, the rejection over the prior art of HERGENROTHER is rested as a 103 in view of FUKUMOTO. The prior art of FUKUMOTO discloses that when

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making tire treads use of clay having particle size of about 1 micron is a general knowledge due to its reinforcing properties.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

In December 2003, Patent Office will be moving its location to Alexandria, VA and as a result phone numbers will change. New phone number for the examiner of record will be 571-372-1127.

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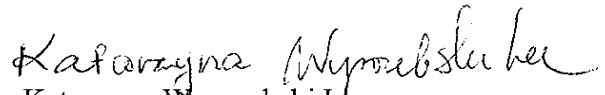
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Katarzyna Wyrozebski Lee  
Primary Examiner  
Art Unit 1714

November 6, 2003